

### **REMARKS**

After entry of this amendment, claims 3, 4, 10 and 17 are pending. Claims 1-2, 5-9 and 11-16 have been cancelled without disclaimer or prejudice. The claims have been amended without prejudice or disclaimer and find support *inter alia* in the original claims. New claim 17 finds support in original claim 10. No new matter has been added.

### **Rejections under 35 U.S.C. § 102**

Claims 1-4 and 10 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kuhnke *et al.* (hereinafter “Kuhnke”). Claims 1 and 2 have been cancelled without prejudice or disclaimer. The rejection of claims 1 and 2 is therefore moot.

The Examiner cites a compound disclosed by Kuhnke (RN number 350233-20-4) and alleges that this compound anticipates the instantly claimed invention. Applicants respectfully disagree.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegall Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

In the compound cited by the Examiner, at the positions corresponding to Applicant’s Formula I, R<sup>1</sup> is Ph, R<sup>2</sup> is Ph, R<sup>3</sup> is n-Pr and R<sup>4</sup> is hydrogen. Ph does not fall within the definition of R<sup>2</sup> in claims 3 and 4 of the present invention. Therefore the cited compound does not anticipate claims 3 and 4. Claim 10 has been amended to recite a pharmaceutical composition comprising a compound according to claim 3 and a pharmaceutically acceptable carrier. Since the cited compound of Kuhnke is not a compound according to claim 3, claim 10 is also not anticipated. Withdrawal of the rejection is respectfully requested.

### **Double Patenting**

Claims 1-4 and 10 are rejected for obviousness-type double patenting over claims 1 and 2 of U.S. Pat. No. 7,550,495 (the ‘495 patent). Claims 1 and 2 of the present application have been cancelled without prejudice or disclaimer. The rejection of claims 1 and 2 is therefore moot.

The Examiner alleges that claims 1 and 2 of the '495 patent render the present claims obvious, since the '495 patent teaches the generic compounds and compositions which are similar to the instantly claimed compounds. Applicants respectfully disagree and traverse the rejection.

The Examiner bears the initial burden of establishing *prima facie* obviousness. *See In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To support a *prima facie* conclusion of obviousness, the prior art must disclose or suggest all the limitations of the claimed invention. *See In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994).

Claim 1 of the '495 patent recites a single compound and pharmaceutically acceptable salts thereof. Claim 2 of the '495 patent recites a pharmaceutical composition comprising the compound of claim 1 and a pharmaceutically acceptable carrier. Since claim 1 recites a single species and its pharmaceutical salts, claim 1 is not a generic claim as alleged by the Examiner. In contrast, claims 3 and 4 of the present invention recite a large number of species according to Formula I that comprise the radical groups  $R^1$ ,  $R^2$ ,  $R^3$  and  $R^4$ . Claims 3 and 4 also provide definitions for these radical groups. Claim 10 as amended depends from claim 3 and therefore contains all the limitations of claim 3. Claims 1 and 2 of the '495 patent do not teach or suggest Formula I, the radical groups  $R^1$ ,  $R^2$ ,  $R^3$  and  $R^4$ , or definitions of these radical groups. Because claims 1 and 2 of the '495 patent do not teach or suggest all the limitations of claims 3, 4 and 10 of the present invention, a *prima facie* case of obviousness has not been established. Withdrawal of the rejection is respectfully requested.

Claims 1-4 and 10 are provisionally rejected for obviousness-type double patenting over claims 1-4 and 10 of co-pending Application No. 10/572,825, over claims 1-4 and 10 of co-pending Application No. 10/572,826, over claims 1-8 and 13 of co-pending Application No. 12/466,415 and over claims 1-6 and 12 of co-pending Application No. 11/575,691. Because this is a provisional double patenting rejection, Applicants will further respond as necessary once the claims are otherwise found allowable.

### **Claim Objections**

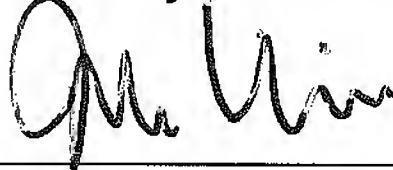
Claims 1-4 and 10 are objected to for containing non-elected subject matter. Claims 1 and 2 have been cancelled without prejudice or disclaimer. The objection to claims 1 and 2 is therefore moot. Claims 3 and 4 have been amended to remove non-elected subject matter. Claim 10 has been amended to depend from claim 3. It is believed that the present amendments overcome the objection. Reconsideration and withdrawal of the objection is respectfully requested.

### **CONCLUSION**

For at least the above reasons, Applicants respectfully request withdrawal of the rejections and allowance of the claims.

Accompanying this response is a petition for a one month extension of time to and including May 7, 2010 to respond to the Office Action mailed January 7, 2010 with the required fee authorization. No further fee is believed due. However, if an additional fee is due, the Director is authorized to charge our Deposit Account No. 03-2775, under Order No. 15652-01309-US from which the undersigned is authorized to draw.

Respectfully submitted,

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